

No. 9693

IN THE

United States Circuit Court of Appeals

For the Ninth Circuit

THE L. McBRINE COMPANY, LIMITED,
Appellant,

vs.

SOL SILVERMAN AND SAM SILVERMAN,
co-partners doing business under the
name and style of Balkan Trunk &
Suitcase Co.,
Appellees.

THE L. McBRINE COMPANY, LIMITED,
Appellant,

vs.

HERMAN KOCH, doing business under
the name and style of H. Koch &
Sons, and HAROLD M. KOCH, WILLIAM
L. KOCH, and REBECCA KOCH,
Appellees.

(CONSOLIDATED
CASES)

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BRIEF FOR APPELLEES.

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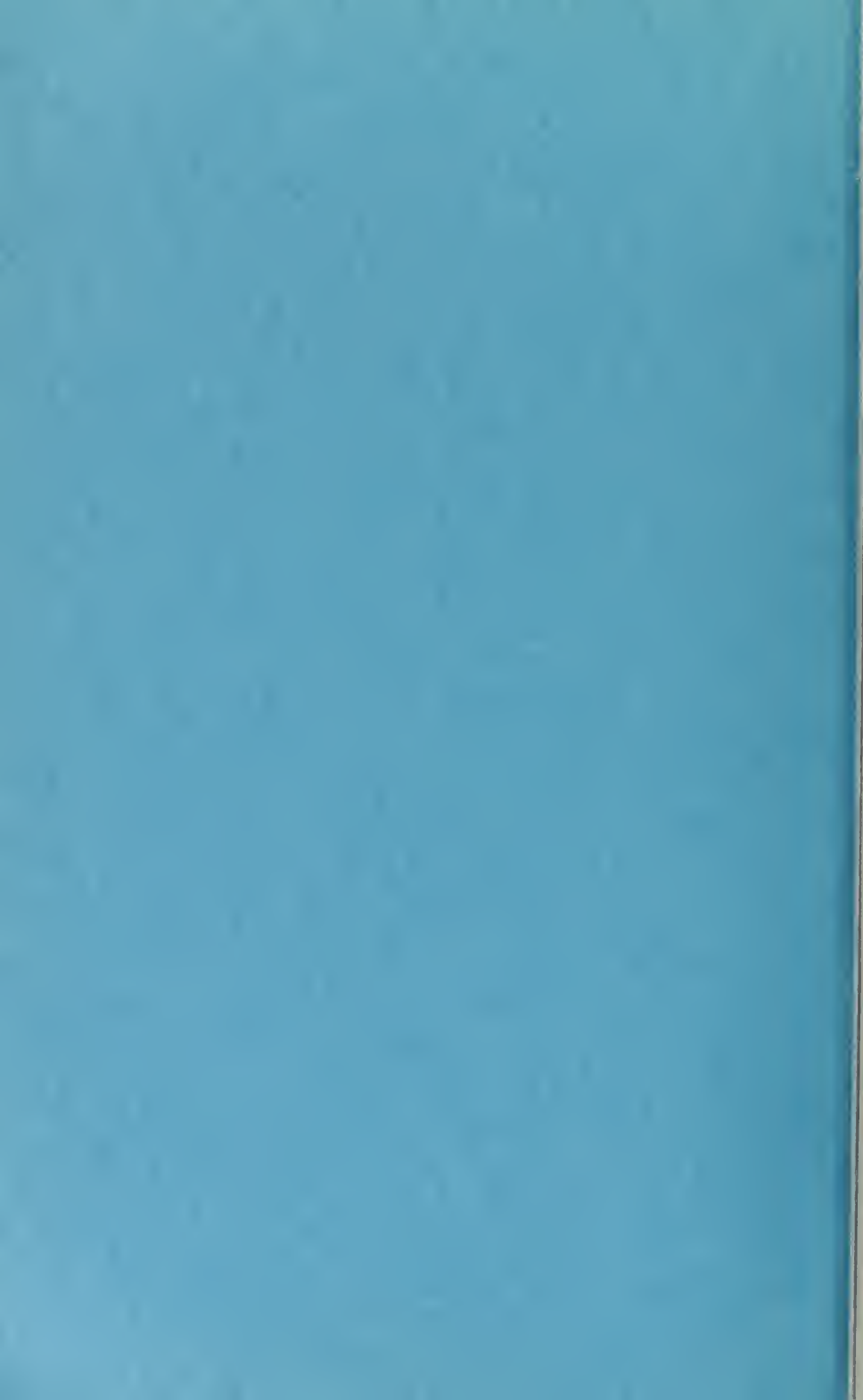
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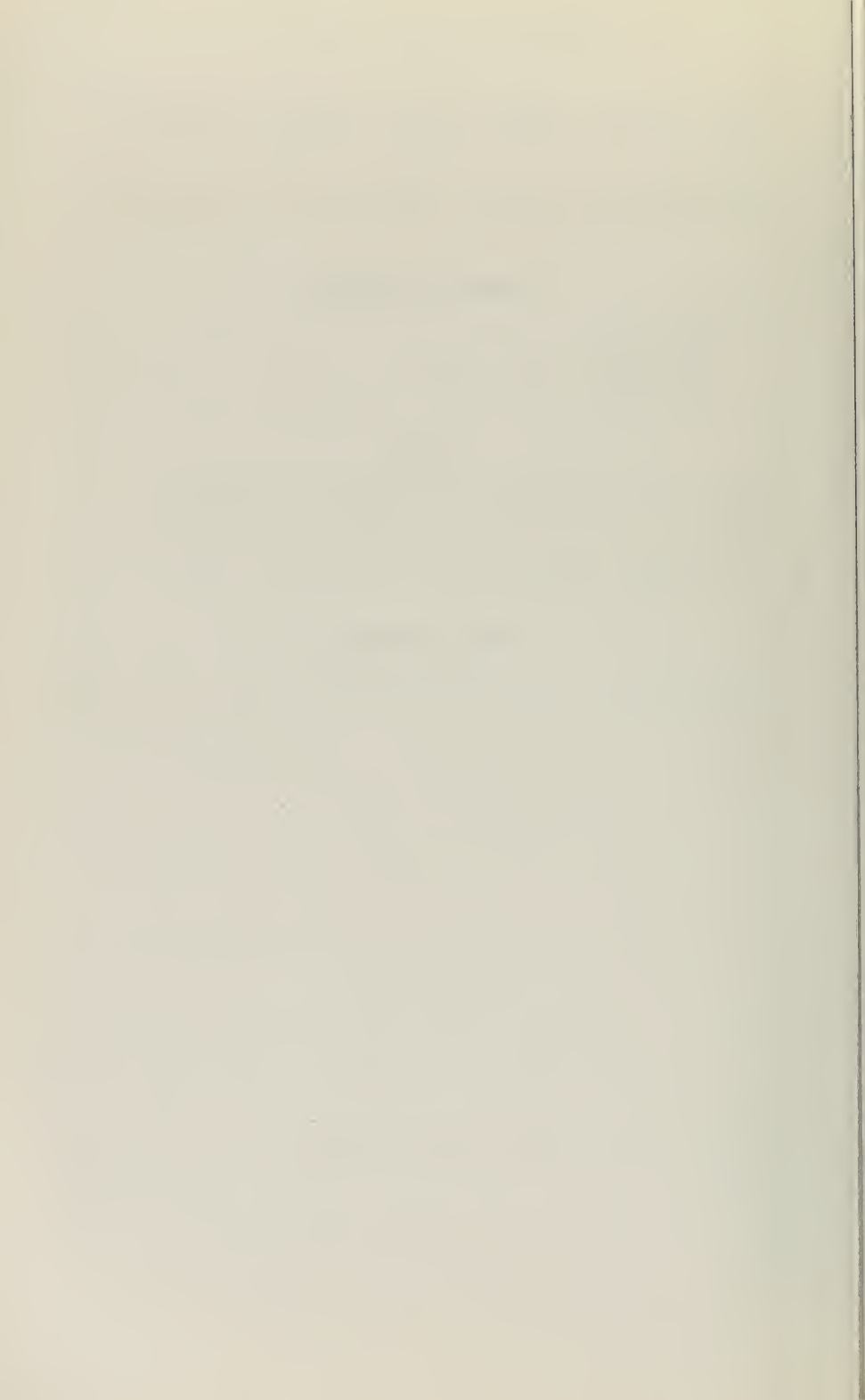
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BRIEF FOR APPELLEES.

INTRODUCTION.

The Shoemaker patent involved in this suit is not as complicated as it would appear from plaintiff's

lengthy explanation in its brief. The patent relates to a garment support in a wardrobe suitcase, a very simple mechanical structure. In the patent structure the garment support consists of a draping frame pivoted directly to the hinged side of the cover of the suitcase, so that garments can be draped on the frame and carried in the cover of the suitcase. In each of the accused structures a very ordinary prior art type of draping frame is employed and connected to the lateral side walls of the suitcase cover by means of links, which allow the draping frame to be bodily projected to a loading or unloading position distant from the cover, and then folded upon the links preparatory to being swung to a packed position within the cover.

Three major defenses were relied upon in the lower Court, namely:

1. Invalidity by reason of prior knowledge, use, and sale by Maurice Koch and his associates.
2. Non-infringement, based on the interpretation of the claims and file wrapper estoppel, and
3. Anticipation as to all material features of the accused structures.

Findings 6 and 7 and Conclusion 1, of the lower Court, holding the claims of the patent in suit invalid, are based on the first mentioned defense namely, the "Koch defense". As the evidence in support of the defenses was adduced in open Court, the lower Court had an opportunity to observe the demeanor of the witnesses and the demonstrations made in Court. The

case was tried at length, it was extensively argued both orally and by briefs, the District Court gave extended consideration to the testimony before it, and its decision should be upheld unless clearly demonstrated to be wrong.

STATEMENT OF ISSUES AND SUMMARY OF ARGUMENTS.

The issues and defendants' contentions may be categorically stated as follows:

1. The evidence, including testimony of witnesses adduced at the trial, corroborated by contemporaneous documentary evidence and specimens of the early "Koch" fixtures, established beyond a reasonable doubt that the Koch fixtures as shown in defendants' exhibits K, L, and S, were invented by Maurice Koch in the early part of 1928, were manufactured by Larkin Specialty Manufacturing Company for H. Koch and Sons, about May, 1928, and luggage embodying the fixtures as shown in said exhibits were known and publicly sold in the summer of 1928, long prior to the alleged date of invention of Shoemaker.

2. The change of location of the pivots of the early Koch fixtures from the lateral sides of the suitcase cover to the hinged side, as in the Shoemaker suitcase cover does not involve invention. If the Shoemaker patent claims in issue are interpreted to "fairly read" on the accused structures, then the claims also "fairly read" on the

1928 Koch fixtures and luggage, and are completely anticipated.

3. The claims in issue cannot be "fairly read" upon the accused structures, when the claims are considered in the light of the file history, and in the light of the express terms and limitations of the claims, and also in the light of the file wrapper references, and of the additional prior art proved in this case; therefore defendants do not infringe.

4. The claims in suit are anticipated, at least as to all material features found in the accused structures, by the United States Patent to Lazar Storch, and for this reason the claims of the patent in suit cannot be construed to cover the accused structures without rendering them void for anticipation by the Storch patent.

5. The alleged commercial success of plaintiff and its licensees would not be determinative of any of the real issues in this case. Even if commercial success were of any importance in this case the evidence herein does not show any commercial success of any luggage that may be attributable to anything disclosed by the Shoemaker patent in suit, and sales are rather due to the use of battery of draping bars, such as that shown in the patent to Levine (R. 679).

The foregoing statement of the issues and the position of the defendant with reference thereto, will serve as a summary of our argument. The questions presented by the summary will be taken up in the order stated.

THE "KOCH DEFENSE".

The Shoemaker patent in suit shows a suitcase. In the cover of the suitcase is a garment support member or frame denoted in the patent by the numeral 12. As shown in Figure 1 of the patent this frame is pivoted or hinged to the particular wall of the cover which is hinged to the body of the suitcase, and is referred to in the patent as the "hinged side" of the suitcase cover. The frame 12 is "H" shaped, one side of which is pivoted to the hinged side of the luggage cover and the other side of which is free. A hanger rod denoted by the numeral 30 in the patent is provided for the hinged or pivoted side of the frame 12. In certain forms of the patent this hanger rod 30 is mounted directly on the hinged edge of the garment support frame. In the form shown in Figure 9 of the patent, the hanger rod 30 is mounted in cup-socket 34 and plate 35 on the lateral side walls of the cover adjacent the pivoted or hinged edge of the frame 12.

In operation of the Shoemaker patent the free edge of the frame 12 is swung out of the cover. The garment is folded over the hanger rod 30 and the latter is placed into the sockets at the hinged edge of the frame 12 and then the frame 12 is lifted into the cover, the garment folding over the free edge or folding strip 23 of the frame 12. Shoemaker alleges a date of invention as "November, 1928" (R. 84).

The prior Koch structure, as shown in the defendants' exhibits K, L, and S, has a fixture in which the side members of the garment supporting frame are pivoted on the lateral sides of the suitcase cover

adjacent the hinged side of the cover so that the free end of the frame swings into and out of the suitcase cover. This frame has on its outer or free end a bar which operates as a folding strip. In the Koch structure there are provided a pair of sockets or cups on the lateral sides of the suitcase cover adjacent the pivots of the swinging frame, and in these cups or sockets is removably held a hanger rod. In operation the free end of the support frame is swung out of the cover. Then the garment is folded over the hanger rod, which latter is inserted into the cups adjacent the pivoted or hinged end of the garment-support frame. Then the frame is swung into the suitcase cover and the garment drapes or folds over the free end or folding strip of the early Koch support frame. The Koch fixtures were ordered in May, 1928 and completed and sold in June, 1928.

The time and manner of actual manufacture, assembly and sale of these Koch fixtures and luggage are proved by the evidence in this case beyond a reasonable doubt, as follows:

Maurice Koch Testimony.

Maurice P. Koch told the story of his work on the suitcase naturally and convincingly (R. 290-300). At the time of the trial his father was in a hospital with a serious heart ailment, requiring the use of an oxygen tent (R. 331). The Koch records and the Koch fixtures and remaining suitcases, if any, had been destroyed by fire about 1931 (R. 307-309).

But despite these handicaps, ample corroborating evidence, documentary and physical, was obtained

from the fixture manufacturer and testified to unequivocally by the men who made the fixtures, kept those records, and by a merchant who sold large numbers of the Maurice Koch suitcases.

Early in 1928, Maurice Koch conceived the idea of putting this roller near the hinged side of the cover and associating it with a swinging draping frame. After thinking about it for some time, a model was made, about April, 1928, and discussed with his father and persons at the Larkins Specialty Manufacturing Company (R. 294) to whom an order was given on May 17, 1928 (R. 295) to manufacture the parts. The date of the order is fixed by the work sheet or production list of the Larkins Specialty Company (R. 683). The first order was for 2000, but the order was subsequently raised to 5000, and possibly increased at a later date, but at least 5000 were ordered, made, installed (R. 296) and sold, as shown by this exhibit and the accompanying exhibits, copies of which appear on pages 684 and 685 of the Record.

These fixtures were in two sizes: one for a suitcase 18 inches high, and another for a 21 inch suitcase. Maurice sold these suitcases from Denver west, starting out with samples in the early part of June, 1928. He produced a pair of the original metal parts, installed in a newly made box, Defendants' Exhibit K (R. 296). He also produced a complete fixture taken from an old broken down box, and also installed in a new box, Defendants' Exhibit L. H. Koch & Sons continued to sell this fixture from June 1928 to 1931 or '32, when the plant was destroyed by fire (R. 299-309).

On cross-examination (R. 300) it was brought out that the Winship type of fixture, shown in the above listed Winship patent, was very popular in the latter part of 1927 and 1928. It was therefore perfectly natural that Maurice, the college graduate, would attempt to improve upon the Winship type of fixture, and nothing could be more natural than that he should lower the location in the suitcase cover.

Maurice did exactly what any intelligent person might have been expected to do in the light of the Winship structure and of the very numerous draping frames of the prior art, including those cited in the application file of the patent in suit.

The testimony of Maurice Koch was fully corroborated by record evidence and by the testimony of credible witnesses, whose knowledge of the facts was not of a character to be forgotten or confused by the lapse of time. This testimony will now be briefly reviewed.

Frank Kapps Testimony (R. 310).

Frank Kapps, now superintendent of the Larkins Specialty Company, worked for that company since 1917, and was foreman of the press room of that company in 1928. He saw the Maurice Koch suitcase; worked on the initial order for 2000 fixtures; and attended to their production. The production list, Defendants' Exhibit M, (R. 683), is partly in his own hand writing (R. 311). This production list was part of the company records from 1928 until he produced it for the purposes of this suit (R. 312-316).

He testified to the fact that the order was expanded from 2000 to 5000 sets of fixtures, as indicated on the production list (318).

He not only identified the production list and the order number appearing thereon, "5-17-B," as indicating the date and month of the receipt of the order, but also the entry 7, 7, 28 as indicating the day, the month and the year of its completion. He testified that the date 7, 7, 28 is in his own hand writing, and was placed there to indicate that the order was on that date formally closed on the books of the company.

He also identified the parts of Defendants' Exhibit K as listed in the production list, Defendants' Exhibit M (R. 313).

As to the assembly of these early Koch fixtures in a suitcase Kapps testified (R. 313-314):

"Q. Did you ever see that assembled in any way in a suitcase, or did you ever see it in any sort of a suitcase?

A. Yes, we put it in a temporary assembly.

Q. What was the purpose of that?

A. To test the width; sometimes we have trouble with the width; they don't fit in there after the covering gets around here, and we always test it; we drill holes and test these and see they are fastened to the frame; the cloth on the side.

Q. Was that assembly in the same position as it is assembled on Defendants' Exhibit K before you?

A. Yes, it was.

Q. Exactly the same position?

A. It was."

And again:

Q. "Have you ever seen a fixture in a finished case in commercial form, that fixture?"

A. I have been down to their factory. In fact, I went down there at the time we were fitting this with the estimator to see whether they went in all right, and we made several of those samples" (R. 319).

T. E. Merryfield Testimony (R. 320).

Mr. Merryfield is, and has been ever since the year 1926, the estimator for the Larkins Specialty Company. He testified that he went with Mr. Kapps to see the original Maurice Koch suitcase and for the purpose of preparing an estimate as to the cost of making the fixtures. He identified the fixture in Defendants' Exhibit K as one which was kept in the company office until taken out a week or two before the trial by Maurice Koch and Mr. White, Counsel for the Defendant Koch et al. Mr. Merryfield fitted this fixture to a Koch suitcase in 1928. It was part of his duty as an estimator to do so (R. 321, 322).

He also identified the production list and produced the ledger book of the company (R. 323). He identified the book entries relating to the order "5-17-B", and a photostat of the page so identified appears in evidence as Defendants' Exhibit N (R. 684). Until so produced for the purposes of the trial the ledger had always been in his custody (R. 324).

He also identified order number 5-17-A as relating to the dies for the garment hangers (R. 324).

Mr. Merryfield also produced a book of invoices (copies of invoices) (R. 325). He identified one of these invoices as relating to the order No. 5-17, and testified that it shows that H. Koch & Sons were billed for 2581 long brackets and 2528 short brackets, made for them pursuant to said order. A photostatic copy of the invoice was put in evidence as Defendants' Exhibit O (R. 684).

Albert W. Kantrow Testimony (R. 334).

Mr. Kantrow is a merchant, and retails luggage. He testified that in 1928 he commenced to handle luggage for H. Koch & Sons made like Defendants' Exhibit S. At that time he was moving his place of business from Folsom Street to Beale Street and had this luggage delivered to Beale Street. He bought the luggage in July 1928, and had the order shipped to Beale Street in September (R. 336). He first bought about 150 or 200, and kept buying them right along after that. He never had any complaints as to their successful operation (R. 336). He sold about 100 to 150 per month, and continued to sell until about 1931 or 1932, "sold plenty".

Plaintiff's Criticism of the "Koch Defense" Testimony is Contradicted By the Record.

The entire attack of plaintiff on this testimony is based on speculation of what "might have been", rather than on the facts of the case. Some of plaintiff's statements are even speculations as to reasons for pleading. We shall now point out the falacies in plaintiff's argument contained on pages 39 to 53 of Appellant's brief.

The first argument of plaintiff is that the above discussed evidence, the testimony of Koch, Kapps, Merryfield, and Kantrow, corroborated by fixtures made in 1928, and by original production order, factory ledger book, accounts, and invoices, is not of the character required to prove prior invention knowledge and sale.

In support of its argument plaintiff on page 40 of its brief refers to the pleadings, but plaintiff does not state the facts fairly. The "Koch defense" was pleaded in the answer by all the allegations required by law (R. 21). Plaintiff complains that the interrogatories for further information relative to this defense filed by plaintiff in "January 1940" were answered by defendants only on "March 9, 1940". The truth of the matter is that "plaintiff's further interrogatories" were filed on January 29th, 1940. Defendants in the Koch case filed their interrogatories thereafter on February 7, 1940 (R. 83). Inasmuch as priority dates were involved the Court ordered the exchange of answers to the interrogatories. Plaintiff's answers to defendants' interrogatories were in Canada on February 22, 1940 (R. 85), and naturally reached San Francisco sometime after that date. Therefore to the very end of February, plaintiff was not ready to exchange answers with defendants relative to priority information. At about that time defendant Herman Koch was "under an oxygen tent" on account of "a heart attack" (R. 331) and counsel for defendants in the Koch case offered to counsel for plaintiff to either obtain a verification of the an-

swer to the interrogatories from Mr. Maurice Koch (who is not a defendant in this case) or to have defendants' counsel verify it. It took a few days before plaintiff agreed to accept verification by the attorney (R. 77). These answers were then exchanged and plaintiff's counsel received the answer to the interrogatories, not on "March 9, 1940", asserted in plaintiff's brief, but on March 6, 1940 (R. 77). In addition to the photograph of the Koch luggage case and fixtures, defendants also furnished photo-copies of the production list, ledger sheet, and invoice, now in evidence (R. 80-81). We submit that from the true history of these answers to the interrogatories no such conclusion can be drawn as that of plaintiff. All the priority evidence was in existence as shown by the unimpeached testimony of four witnesses, and could have been furnished sooner, had plaintiff asked for it sooner.

Plaintiff also consistently misconstrues the testimony of Mr. Koch. He definitely testified that only the wooden parts were made for the trial, all the metal fixture parts were original fixtures made by the Larkin Specialty Manufacturing Company in 1928 (R. 296). This is amply corroborated by Kapps and Merryfield.

The next objection plaintiff raises is that Koch did not produce the "old box" in which the fixtures of Exhibit L were found. In this case defendants concentrated their proof on the fixtures that were all these years since 1928 in the possession and under the control of the Larkin Specialty Manufacturing Com-

pany and their employees. In concentrating scrupulously on evidence which never left the possession of the manufacturers until the preparation for this trial (R. 321-322), defendants conclusively proved both the time of manufacture of the fixtures and the manner of assembly by disinterested witnesses, Kapps and Merryfield, without the necessity of further cumulative evidence. It is evident that if the defendants were dishonest, as plaintiff insinuates, it would have been easy to install all the fixtures in some "smashed boxes". The mere fact that defendants did not bring in an old box does not impeach the straightforward testimony of four witnesses corroborated by contemporaneous physical and documentary evidence. It is strange that plaintiff raises such criticism, although plaintiff did not produce a single early suitcase made according to the structure shown in the Shoemaker patent. Instead plaintiff resorts to some very recent Hartman wardrobe suitcases (plaintiff's Exhibits 5 and 6) which do not resemble at all the structure Shoemaker described in his patent.

On pages 43 to 44 of Appellant's brief plaintiff speculates about the reasons for the relatively short arms of the early Koch fixture. As it was explained by Koch, the arms of the frame in the early Koch fixtures were long enough. These arms are about $12\frac{1}{2}$ inches, which accommodate in the cover a dress over 50 inches long, which is still longer than the average woman's dress was in 1928 (R. 302). The arms of the fixture in Plaintiff's Exhibit 6, plaintiff's licensee's "Sky-Robe" case, are collapsible to $11\frac{1}{2}$ inches, even

shorter than the arms of the 1928 Koch fixture. This same Exhibit 6, has in it a 58-inch sheet, which bears the legend that "This 58-inch represents a length considerably longer than the average woman's dress". Plaintiff should believe the instructions of its own licensees. The Koch fixture was long enough and disproves the first premise for the theoretical arrangement of plaintiff opposite page 44 of its brief. As plaintiff admits, any luggage manufacturer would immediately recognize the desirability of accommodating garments of maximum length. Therefore it was logical for Koch in 1928, to use the fixture in the manner shown by the evidence for folding the garment four-fold. No luggage manufacturer would use an impractical, loose swing frame as "imagined" by plaintiff opposite page 44 of its brief. The theoretical arrangement plaintiff suggests in its brief lacks utility.

The other speculative position "imagined" by plaintiff is the mounting of the cups for the Koch hanger rod in the top of the suitcase cover. Plaintiff draws inspiration for this arrangement from the prior patent of Fasel and Garland (R. 558). Plaintiff in this speculation again disregards the physical facts of the case. The cup brackets, defendants' Exhibit R, are plain cylindrical cups. The opening on the sides of these cup brackets is larger than the ferrules on the ends of the hanger rods, as manufactured by Lar-kins Manufacturing Company in 1928. Therefore the hanger rod would not stay in the cups if placed in it as shown in the hypothetical position on page 44 of

Appellant's brief. If the suitcase was turned or moved around the hanger rod would fall out of the cup brackets if mounted in the hypothetical position asserted by plaintiff. Plaintiff in comparing this condition with the Fasel et al patent entirely disregards the teaching of the Fasel patent (R. 562, lines 43-57) which provides for "spring tongues" to clamp the hanger rod into the *fixed* Fasel brackets. Neither the production list, nor the testimony of the mechanics Kapps and Merryfield, nor any part of the record suggests such a location and assembly for the parts of the Koch fixture as shown by plaintiff on page 44 of its brief. On the contrary in the 1928 Koch fixture, the pivoted ends of the arms are bent inwardly so as to overly the openings of the cup-brackets and hold the hanger rod in position. The design and construction of the early Koch fixture contradicts completely the speculation and theories of plaintiff about the assembly of the Koch fixture in the suitcase.

Then plaintiff on pages 45-46 of its brief argues about the reasons for the mistaken reversal of the cup-brackets in exhibits K and L. The cup-brackets are small structural parts, more or less hidden from view. The location of these cups is the same in all the exhibits, except that in Exhibit S, the openings of the cups are turned toward the cover.

In demonstrating Defendants' Exhibits K and L, in open Court it was found that the hanger rods or rollers tended to pull out of their metal fastenings. Mr. Koch was evidently surprised and confused when this was called to his attention. But after he left the

stand he found that the workman who had been entrusted to put the metal cups in place had reversed them. These metal cups are cut away and are intended to be assembled so that the higher side is toward the front. Reversal of the cups brought the lower walls of these openings to the upper and front side and allowed the rod to lift out under tension of the clothing. Mr. Koch had another case made with the cups properly installed, and was recalled to again demonstrate the working of his fixture and explain his mistake.

This error in assembling Defendants' Exhibits K and M,—instead of discrediting Mr. Koch,—gave to the Trial Court an excellent opportunity to judge of his credibility. A dishonest witness would have broken down under such conditions, whereas, although Mr. Koch was evidently surprised when the hanger rod slipped out of place and while under such surprise was lost to satisfactorily explain the reason, his frankness was apparent and his honesty was established in the mind of the Trial Court by his demeanor on the witness stand under such trying circumstances.

Incidents of this character always give to the Trial Court the best possible opportunity to judge of the credibility of a witness. An honest witness, when taken by surprise, does not try to conceal his confusion, whereas a dishonest witness tries to escape by falsification, and his demeanor leaves no doubt as to his dishonesty.

No one who saw Mr. Koch when he gave his testimony could have any doubt as to his honesty.

The excerpts from the testimony quoted on pages 47-49 of plaintiff's brief are fragmental and do not fairly represent the testimony of the respective witnesses. The quoted Koch testimony on page 47 of Appellant's brief refers to the 1927 Winship cases (R. 291) and does not refer to the 1928 Koch suitcases and fixtures. The quotations on page 48 of plaintiff's brief again refer expressly to the Winship type case and not to the 1928 Koch suitcases and fixtures. Koch expressly testified as follows:

“Q. Did you sell, or, to your knowledge, did H. Koch & Sons ever manufacture any luggage with that fixture installed into any other part than in the cover of the luggage as shown in Defendants' Exhibit K?

A. You mean did we use this fixture in any other part of this type of luggage?

Q. Yes.

A. No, just in the lid of the cover, just as you see it there.

Q. Did you ever install it in any other way than shown in Exhibit K, in any other manner?

A. No, the hanger couldn't be used any other way” (R. 299).

The criticism of the Kapps' testimony as to difference from the specification of the production list is misleading because Kapps' testimony was that “as far as the operation goes” they follow the production list, but the material used may be thicker or wider, according to what can be purchased (R. 317).

When plaintiff quotes one sentence of the Kapps' testimony on page 48 of its brief, plaintiff does not

fairly present the meaning of that sentence when considered in the light of the entire testimony. For instance the part quoted by plaintiff from Kapps' testimony on page 48 of its brief is part of the following testimony (R. 318-319):

“Mr. Morsell. Q. As to seeing this fixture assembled in a cover, you are testifying merely from memory, are you not?

A. So far as seeing it in a cover?

Q. Yes.

A. I am only testifying from this date that is on here. I couldn't testify any other way. I couldn't remember what I did fifteen years ago.

Q. I mean your recollection of having seen it assembled in a cover.

A. It is purely from this date that we manufactured—I mean we did the model work on all of them and we had one of these covers up there, and we worked on it at the time.

Q. You are just recalling from recollection that you did see that assembly in that cover?

A. I did see it in there, yes.

Q. Through the years since then you have seen other fixtures installed in other cases, I presume?

A. Yes, three or four that they developed since then.

Q. Have you ever seen a fixture in a finished case in commercial form, that fixture?

A. I have been down to their factory. In fact, I went down there at the time we were fitting this with the estimator to see whether they went in all right, and we made several of those samples.”

Plaintiff even resorts to quoting only a half of a sentence of Kantrow's testimony. Plaintiff "to emphasize" its "theory that the removable bars in the Koch exhibits might very logically have been independently in the upper end of the luggage" quotes a fragment of Kantrow's testimony on page 49 of its brief, thus: "About 1925 and 1926 I was buying cases that had two little rods on the top * * *." However if this sentence and his testimony is completed it reads, thus:

"A. Well, about 1925 and 1926 I was buying cases that had two little rods on the top, and then Mr. Koch came out and showed this case, there, to me.

Q. Pointing at Defendants' Exhibit S. Could you approximately fix the date when you first purchased the kind that is in Defendants' Exhibit S?

A. I couldn't say the exact day, but I know it was the month of July, but I couldn't say the date exactly.

Q. You couldn't tell the year?

A. Yes, 1928" (R. 335).

This analysis of plaintiff's argument as to the prior art testimony clearly shows that plaintiff's conclusions and theories are based on erroneous premises.

The Prior Koch Luggage Fixture Anticipates the Shoemaker Claims.

Plaintiff argues on pages 49 and 50 of its brief that the prior Koch fixtures shown in Defendants' Exhibits K, L, and S do not anticipate the claims

of the Shoemaker patent. The main difference between the early Koch garment support and that shown in the Shoemaker patent is that the frame of the Shoemaker patent is pivoted directly on the "hinged side" of the luggage cover, while the Koch fixture is pivoted on the lateral sides of the cover, adjacent the hinged side thereof. Inasmuch as plaintiff insists upon a construction of the claims to include draping frames pivoted to the lateral sides of the cover, therefore the Koch structure is a complete anticipation of the Shoemaker patent claims in suit. The mere change of location of the pivot of the frame to the hinged side as in the Shoemaker patent does not amount to invention.

Plaintiff argues however that the Shoemaker claims define a structure wherein the hanger rods or bars are mounted on the "inner end" of the draping frame. It is characteristic of plaintiff's argument throughout the brief that plaintiff nowhere analyzes the language of the claims in suit. For instance claim 27 in the last clause recites:

"a garment supporting means in said cover *adjacent* the first mentioned side of said member."

The "garment supporting means" recited in the claim is admittedly the hanger rod 30 of the patent as shown in Figure 9 of the Shoemaker patent, and is adjacent the hinged side of the supporting member or frame, but not "carried on" it. Therefore plaintiff on the one hand insists upon a broad construction of the claims to include all the embodiments

of the Shoemaker patent within the scope of the claims, and on the other hand plaintiff would like to exclude the prior Koch fixtures as anticipations because the Koch fixtures are assembled similarly to Figure 9 of the Shoemaker patent, and not as in Figure 1 of the Shoemaker patent. This inconsistency of plaintiff demonstrates further the weakness of plaintiff's entire argument.

The fallacy of plaintiff's argument is further demonstrated, when plaintiff reasons that the position of the Koch hanger rod causes elongation and strain on the garment. The effect of this action is described by Koch as beneficial, he stated:

“There may be a stretching of the garment to keep it wrinkle proof” (R. 333).

Plaintiff's expert thought that the same action may be injurious (R. 412). However when plaintiff's expert demonstrated “the Shoemaker patent” with Plaintiff's Exhibit 6 (R. 414), then it was found that relative to the lowest hanger bar in Plaintiff's Exhibit 6, there was also an elongation of about $1\frac{1}{4}$ inches (R. 414-418), and this bottom rod in operation is held in place by the other rods in the bracket. Evidently plaintiff's licensee does not agree with plaintiff's expert and with plaintiff's argument as to any disadvantages of the hanger rod position shown in the Koch fixtures, because plaintiff's licensee manufactures luggage with hanger rods in substantially the same relation to the pivot of the frame as the early Koch structure (Plaintiff's Exhibit 6, R. 414-

418). It would not involve invention to transfer the early Koch hanger rod from its position shown in Exhibit S to the hinged end of the frame.

The Koch testimony quoted by plaintiff on page 50 of its brief refers to the fact that the accused Koch structure is a modern fixture and differs from both the early Koch fixture and from the Shoemaker patent. This difference of the accused structures from the Shoemaker claims will be hereinafter argued in connection with the issue of infringement.

So far as the comparison of the early Koch structure with the Shoemaker patent is concerned, the evidence shows that the minor structural differences between the Shoemaker patent structure and the prior Koch fixtures do not rise to the dignity of invention, and the Shoemaker claims do not define anything patentable over the prior Koch fixtures.

The Evidence of Koch Priority Satisfies the Law On the Quality of Proof.

The fact situation of this case distinguishes from the fact situation of the *Barbed Wire Patent* case, and from the quotations on pages 52 and 53 of Appellant's brief, in that in this case in addition to the oral testimony of reputable disinterested witnesses, there are contemporaneous physical and documentary exhibits from which the dates and nature of the prior structure can be ascertained. As we heretofore pointed out three out of the four witnesses are disinterested. Koch is the son of one of the defendants, but Kapps and Merryfield are employees of the Lar-

kins Specialty Manufacturing Company, and are not even remotely interested in the outcome of this litigation. Kantrow is a dealer in luggage and is not affected in any different way than thousands of other luggage dealers all over the United States would be. The physical exhibits include the original metal fixtures manufactured in 1928, the original 1928 production list (Defendants' Exhibit M), the books and records of the Larkins Specialty Manufacturing Company (Defendants' Exhibits N, O, P). All these physical exhibits and documents were positively identified both as to date and nature of article, by the men who were in charge of the same since 1928. The evidence here establishes both the date and the nature of the prior Koch structure beyond a reasonable doubt.

The rule stated by this Court in the case of *Rown v. Brake Testing Equipment Company* (C. C. A. 9), 38 Fed. (2d) 220, 224, is fully applicable to this case:

“To reject such testimony taken as a whole, or to decline to believe it, would in effect, be to nullify the provision of the statute, by exacting an impossible standard of evidence. The testimony is not contradicted, is not inherently improbable, and would, we think, be accepted as satisfactory and convincing, if not wholly conclusive, in any other kind of case, criminal or civil.”

The decision of this Court in *Waterloo Register Company v. Atherton*, 38 F. (2d) 75 (C. C. A. 9) is also in point:

“The rule is well settled, of course, that a defense of this kind must be proved with certainty and beyond reasonable doubt; but whether the proof measures up to that requirement, or not, is ordinarily for the trial court to determine. An appellate court cannot interfere, unless it can be said as a matter of law that the testimony is legally insufficient to establish the defense with the requisite degree of certainty.”

“The prior public use in this case was testified to by four witnesses, three of whom were without interest in the result. Three of the witnesses fixed the date of the prior use by reference to dates contained in deeds to which they were parties, and the fourth was certain as to the date, but was unable to fix it by reference to any writing” * * * “Under such facts, it is not at all surprising that the court below reached the conclusion embodied in its decree.”

The rules are similarly stated in the case of the *Parraffine Companies v. McKeeverlast, Inc.* (C. C. A. 9), 84 Fed. (2d) 335 at 339, and in *Becker v. Electric Service Supplies Co.*, 98 Fed. (2d) 366, at 368.

We also rely on Rule 52 of Federal Rules of Civil Procedure that “Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial Court to judge of the credibility of witnesses.” We submit that findings 6 and 7 and conclusion 1 of the District Court in this case should not be set aside, and should be affirmed.

NON-INFRINGEMENT.

Under this heading we will discuss the scope of the alleged Shoemaker invention, and will point out that the claims in suit if properly interpreted do not read on defendants' accused luggage, even if the claims were held valid.

A suitcase is a box with a hinged cover. For many years suitcases had contained draping frames upon which to fold or wind garments to prevent them from wrinkling.

Shoemaker, the patentee of the patent in suit, fixed the date of his conception in November 1928.

The limited character of his contribution is made evident by a consideration of the immediately precedent art, viz:—

Langmuir Patent (Figures 2 and 4) (R. 653),
Application June 11, 1927.

Suitcase similar to a wardrobe trunk, with primary draping hanger 4 near top cover hinge and secondary draping frame 11 pivoted at bottom of chamber to swing upwardly for secondary draping, giving garment a three-ply fold.

Winship Patent (Figure 1) (R. 569),
Application August 16, 1927.

Draping frame pivoted to side margins of cover and provided with removable draping hanger bar 21. This frame folds upwardly.

Pownall Patent (Figure 1) (R. 667),
Application January 21, 1928.

Draping frame in three sections 8, 9 and 10. Section 8 folds downwardly, Section 9 lies adja-

cent the hinged side of cover, and Section 10 pivots on Section 9 to swing out over body for draping purposes. It has a battery of removable hanger bars 23.

Laprade Patent (Figure 1) (R. 657),
Application April 28, 1928.

Clothes supporting partition 10 pivoted at cover hinge, and provided with a removable clothes hanger 16. Co-operating straps 22 and 23 are used to hold the partition and the garments in place.

Note: At this stage Defendant Koch produced his anticipating suitcase, Defendants' Exhibit S, and established a business which continued for several years, until the plant burned.

Storch Patent (R. 662),
Application (in Austria) September 1, 1928
and in the United States May 9, 1929.

Links A-A' pivoted to cover near hinge to connect a draping frame pivoted to the other ends of the links and bodily projectible from cover to loading position. This frame is swung in either direction for a winding operation, to secondarily drape the clothing, and then carried by the links into the cover.

Wheary Patent (Figure 3) (R. 578),
Application April 22, 1929.

(Priority over Shoemaker decreed).

Draping frame 29 hinged to body brackets 31 near cover hinge and swinging into and out of cover.

Hamlin Patent (Figure 5) (R. 675),

Application November 15, 1928.

Draping frame with primary hangers 17 and 18 near hinged side of cover. Suspended by hooks 28 from near free side of cover, and provided with a secondary draping bar 21 near free side of cover.

Additional prior art patents show loose garment draping frames which are for the same purpose as the Shoemaker garment supporting frame 12, and function the same way. Such draping frames of the prior art are shown in the patent to Hopkins (R. 611), the British patent to Schwarzenberger (R. 531), and the British patent to Duverge (R. 535). The Shoemaker patent admits at page 2, lines 77 to 86 (R. 463) that loose draping frames rested against the inner face of the hinged side of the cover would constitute practically the same action as when the frame was hingedly connected to the hinged side of the cover.

All of the foregoing is prior art, and the patent in suit merely contributed the idea of pivoting the draping frame *directly* to the hinged side of the cover, instead of *linking* it to the side walls so that it could project bodily.

Whether the claims in issue fairly cover the accused structure depends upon the meaning of the phrase "hinged side of the cover". This can be determined by reference to the file wrapper history and to Shoemaker's own depositions.

ARGUMENT RE FILE HISTORY.

The patentee, E. J. Shoemaker, entered the Patent Office with eleven claims (R. 482). Claim 7 was the only one which specified the clothes support as "hingedly connected to the hinged side of the cover", and this was the only claim indicated as allowable on the first action (R. 486).

The original claims 1, 2, 3, 4, 8, 9, 10 and 11 each called for a connection of the fixture "relative" to the hinged side of the cover, and all of these claims were rejected upon the patent to Boyd (R. 553). Claims 5 and 6 were also rejected as functional.

To avoid the Official Rejection, the applicant amended all of these claims to definitely limit them to a mounting of his fixture on the hinged side of the cover and added claim 12 (R. 492) which read as follows:

"12. Luggage comprising a body portion, a cover hingedly carried by said body portion, a supporting member adapted to be carried therein, the *end* of said member adapted to *rest against the hinged side* of the cover, being provided with a removable hanger rod, on which garments may be folded and the opposite end of said member adapted to act as a folding edge when the said supporting member is moved to packed position in said cover." (Italics ours).

If there were any doubt as to what the patentee meant by the expression "hinged side of the cover", the above quoted original claim 12 should dispel that doubt.

In the specification, page 2, lines 77 to 86, inc., the description of Figure 10 reads as follows:

“In Fig. 10, the hinging or pivoting of the end of the base portion of the supporting member 12 is done away with, but in packing luggage this end is rested against the *inner face of the hinged side of the cover* and the folding strip pivoted to position, which constitutes practically a similar action as would take place if the base portion was hingedly connected to the hinged side of the cover portion.” (Italics ours).

Also from page 3 of the specification, commencing with line 98 (R. 464), we quote:

“Referring to Figure 9, I provide a supporting member which may be pivotally or hingedly mounted relative to the *inner face of the hinged side* of the cover portion. In this construction the roller is removably mounted *adjacent* the *hinged side* of the cover portion and in co-acting relative position to the base portion of the supporting member 12.” (Italics ours).

If plaintiff's expert is correct in saying that the “hinged side” means hinged half of the cover, then the roller or hanger bar 30 must be *outside* of that half of the cover, for it can hardly be said to be adjacent to it if it is in it.

SHOEMAKER DEPOSITION.

Shoemaker, patentee of the patent in suit, testified as follows (R. 143-145):

“Q. Did it make any difference whether the fixture, as you call it, is pivoted or is to be pivoted to the hinged wall of the cover or to the side-walls?”

A. For purposes of construction we favored the hinged side as being more practical.

Q. Why was it more practical?

A. Because it was more adaptable to different constructions of luggage cases.

Q. Clothing less likely to catch?

A. No. The construction I refer to was the matter of the box, the foundation of the case itself, and how it was adapted to have a fixture fastened to it.

Q. Explain that a little further, as to just why you chose the hinged side of the cover?

A. Well, the base could be made of a material like wood and the rest might be soft leather.

Q. You mean the base of the cover?

A. I mean—yes, the hinged side of the cover.

Q. You refer to the hinged side of the cover as the base?

A. Yes.”

In the same deposition (R. 120), Mr. Shoemaker was asked on direct examination:

“Q. Where is that rod 30 located?

A. Which is located near the hinged side or base portion of the cover.

Q. Is it also located near the hinged side of the supporting member 12?

A. Yes, at near the hinged side of the supporting member 12.”

This was before Plaintiff’s “expert” witness developed the beautiful theory that the expression “hinged side” means “hinged half”.

But it was not before Plaintiff developed the other beautiful theory that “pivoted to” means “located near”.

In view of the foregoing, it will be apparent from the file history, the specification and claims of the patent in suit, and from the Shoemaker deposition—that the expression “hinged side of the cover” and the expression “inner face of the hinged side of the cover” were, and are, used to specifically define the particular wall of the cover to which the body hinges are attached.

When Shoemaker cancelled the word “relative” from his claims without substituting any other word indicating adjacency, he intended to abandon, and did abandon, all effort to monopolize anything other than a direct connection of his fixture to that particular wall of the cover. He is estopped to now assert any broader interpretation for his claims.

THE INTERFERENCES.

There were three interferences. In each, judgment of priority was rendered against Shoemaker. The interference counts are printed in the Record on pages 495, 496, and 497, respectively. They also appear as claims 8, 9 and 16 in the patent granted to Wheary et al., the prevailing party (R. 576). They originated in the Wheary application. The first one reads as follows:

“In the case type luggage carrier including a main section member and a cover member hingedly

connected to one marginal edge thereof, a garment carrying frame, means hingedly mounting the garment carrying frame for movement independently of the cover member to lie over the main section member and for movement substantially parallel with that of the cover member, and means whereby the point of pivot of the garment carrying frame is disposed within the cover member when the garment carrying frame and the cover member are closed over the main section.”

In the Wheary drawing the clothes support is pivotally mounted *adjacent*—but not on—the hinged side of the cover.

After the adverse judgment of priority the Primary Examiner again rejected all of the applicant's claims not specifically limited to a mounting of the clothes support on the hinged side of the cover. In this action, the Examiner not only cited the adverse interference decision, but also cited prior patents to Fasel, et al. (R. 558), Steuwer (R. 564), and Winship (R. 568).

Thereupon the remarkable part of the application history commences. Several personal interviews occurred between the attorneys for Shoemaker and the Official Examiner (R. 508, R. 510), whereupon the patent in suit finally emerged with 28 claims, including the ten claims in issue. All of these claims ring the changes on other details, *but each retains the specific limitation which the Examiner had from the first insisted upon,—the pivotal mounting of the clothes support on one side of the cover, viz.—the hinged*

side,—as distinguished from the Koch, the Storch, the Wheary and the accused structures, each of which disclosed an *adjacent* mounting.

Of the ten claims in issue, claims 4, 8, 11 and 19 point out and distinctly claim a clothes support, hingedly “*connected to*” the hinged side of the cover.

Claims 10 and 24 each substitute “*carried by*” for “*connected to*”.

Claim 12 substitutes “*supported on*” for “*connected to*”.

Claim 23 substitutes “*mounted * * * on*” for “*connected to*”.

Claims 26 and 27 each specify the clothes support as having one side “*hingedly connected to one side of said cover and the other side adapted to swing to a position adjacent the other side of said cover*”. (Italics, of course, ours).

These claims 26 and 27 are meaningless if the word “*side*” does not mean one marginal wall.



CONTROLLING AUTHORITY AS TO THE FILE HISTORY.

From the foregoing it will be apparent that the file wrapper and contents of the patent in suit (Defendants’ Exhibit A) discloses a history remarkably similar to that of the Jardine patent, passed upon by the Supreme Court in *Schriber-Shroth Co. v. Cleveland Trust Company*, 61 Sup. Ct. Rep. 234, 47 U. S. P. Q. 345.

This decision is controlling as to file wrapper estoppel.

In both histories a feature originally claimed was disclaimed by cancellation; in both there was an interference, and judgment of priority against the applicant, followed by a complete revision of claims; in both, the substitute claims included minor details, not mentioned in the cancelled claims; in both there was an attempt by the assignee of the patent to obtain a Court interpretation of the claims which would give them the meaning of the cancelled claims; and in both a Lower Court had adopted the interpretation contended for by the Patent owner and found the claim to fairly cover the Defendant's structure.

In the *Schriber-Shroth Co.* case the Supreme Court reversed the Court of Appeals for the 6th Circuit, and we quote the following, commencing with the last paragraph on page 239 of the Supreme Court Reporter:

“It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected and the claims allowed cannot by construction be read to cover what was eliminated from the patent.” (Citing authorities.)

“The patentee may not by resort to the doctrine of equivalents give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer.” (Authorities.)

“The injurious consequences to the public and to inventors and patent applicants if patentees were thus permitted to revive cancelled or rejected claims and restore them to their patents are manifest.” (Authority.)

PLAINTIFF'S EXPERT.

No professional expert was required to explain the simple structures involved, and the Defendants called no such expert. The only apparent reason why the Plaintiff called an expert was the Plaintiff's desire to interpret the claims to suit its own purposes and give them a meaning corresponding to that of Shoemaker's original claims, which were rejected and cancelled in the face of prior art and an adverse decision in an interference proceeding.

In Webster's New International Dictionary, Second Edition, p. 2330, precedence is given to the following definition of the word “side”:

“I. A border of an object.

* * * * *

4. * * * b. One of the surfaces that define or limit a solid, esp. one of the longer surfaces; a part as a wall of a room) connecting the extremities of the top and bottom; a face; as *the side of box*, a plank * * *”

In Webster's International Dictionary (copyrighted 1927), precedence is given to the following definition of the word “side”:

“the margin, edge, verge, or boundary of a surface”.

We have already quoted the patent in suit, original claim 12, and claims 26 and 27 to show unequivocally that the word "side" has the meaning given to it by the above quoted dictionary definition.

Nevertheless, under the guise of "testimony" the argument was made that the expression "hinged side of the cover" means the entire half of the cover nearest the hinges which connect the cover and body (R. 252), and that the links pivoted to the side walls of the cover in the accused structure, and which connect these walls with the projectible clothes draping frame, can be regarded as clothes supports for the purpose of making out a case of infringement, notwithstanding the fact that the clothes are first supported by the draping frame at a point distant from the cover and then carried into the cover by a somersault movement, aided by the links.

When Shoemaker cancelled the interference claims and allowed priority to be awarded to Wheary, he became estopped to assert as his invention a clothes draping frame pivoted in a suitcase *adjacent* the cover hinge.

Chester & Weaver, Inc. v. American Chain Co. Inc., 9 F. (2d) 369 (C. C. A. 9).

When words of limitation represent a thought essential to that which the inventor regarded as his new step, their limiting effect cannot be neutralized by invoking the rule of equivalents.

Arnold Creager v. Bartville Brick Co. et al., 246 Fed. 441 (C. C. A. 6).

Courts have no right to rewrite claims and thus enlarge them beyond the scope of what the inventor claimed and the Patent Office allowed.

Reinharts, Inc. v. Caterpillar Tractor Co., 31 U. S. P. Q. 264, p. 273 (C. C. A. 9).

“The Courts have no right to enlarge a patent beyond the scope of its claims as allowed by the Patent Office. As patents are procured *ex parte*, the public is not bound by them but the patentees are, and the latter cannot show that their invention is broader than the terms of their claim. If broader, they must be held to have surrendered the surplus to the public.”

Minerals Separation Ltd. v. Butte Superior Copper Co., 250 U. S. 336.

CLOTHES SUPPORTING MEMBER.

It is significant that on R. 276-277 the Plaintiff's expert adopts a different definition of the term “Clothes Supporting Member” from that used in his discussion of this clothes supporting member on Defendants' structure.

On R. 276-277-278, the witness admits that the pivot pin 22 in Fig. 7 of the Shoemaker patent “is not near the hinged side of the cover”. In the lower portion of page 277 he defines the garment supporting member as the H-shaped assembly and says it is connected to the cover through what he terms the auxiliary arms 21. At the top of the next page he says that *consequently* it is proper to say that the garment supporting

member is pivoted *relatively* to the hinged side of the cover. Near the bottom of the same page, he declines to commit himself as to whether he regards Fig. 7 of the Shoemaker patent as being within the scope of the claims.

It is to be noted that in this testimony Plaintiff's expert regards the H-shaped frame as the clothes supporting member and the link bars 21 as "auxiliary arms", whereas when seeking to make out a case of infringement against the Defendants, on R. 220-221, he says that the link bars employed by the Defendants are the clothes supporting member and the frame upon which the clothing is primarily and secondarily draped is merely an "auxiliary extension".

Thus, for the purpose of the attempt to establish infringement, the witness regards the link bars of Defendants' structure as being the clothes support called for by the claims in suit, and the frame upon which the clothes are draped he regards as merely an auxiliary extension, whereas when discussing Fig. 7 of the patent in suit, he recognizes that the link bars are merely "auxiliary arms" and that the *draping frame upon which the clothing is hung* is the clothes supporting member, and declines to say that the claims cover this structure.

STORCH PATENT PRIORITY.

United States Letters Patent to Lazar Storch No. 1,794,653, Defendants' Exhibit H7 (R. 661-665), were granted on an application filed May 9, 1929, within

twelve months after said Storch had filed an application in Austria for a patent for the same invention. The Austrian patent is numbered 116,893 (R. 538). Translation on R. 542. The application for it was filed in Austria September 1, 1928, and the Oath accompanying the United States application recites this fact (Defendants' Exhibit E) (R. 415).

Under Section 893 R. S. U. S., this Court will take judicial notice of the following facts:

Long before the year 1928, Austria and the United States became members of the "International Union for the Production of Industrial Property". Walker on Patents, Deller's Edition, p. 1038.

The Treaty Convention, as amended at The Hague, November 6, 1925, is printed in "Industrial Property Protection Throughout the World", an Official publication of the U. S. Department of Commerce. The pertinent part of it reads as follows:

"Art. 4.—(a) Any person who has duly applied for a patent, the registration of a utility model, industrial design or model, or trade-mark in one of the contracting countries, or his legal representative or assignee, shall enjoy, subject to the rights of third parties, for the purposes of registration in other countries, a right of priority during the periods hereinafter stated.

"(b) Consequently, subsequent filing in any of the other countries of the Union before the expiration of these periods shall not be invalidated through any acts accomplished in the interval, either, particularly, by another filing, by publication of the invention, or by the working

of it, by the sale of copies of the design or model, or by use of the trade-mark.

“(c) The above mentioned periods of priority shall be twelve months for patents and utility models, and six months for industrial designs and models and trade marks.

“These periods shall start from the date of filing of the first application in a country of the Union, the day of filing is not counted in this period.”

Austria's adherence to the Treaty as amended in 1925 was announced in the Official Gazette of the United States Patent Office, 372 O. G. 1009, Column 1, and therefore the above quoted portions of Section 4887 R. S. U. S. gives to the Storch U. S. Patent an effective filing date as of September 1, 1928. This is prior to Shoemaker's date of conception, testified by him to have occurred in November, 1928 (R. 116).

Section 4887 R. S. U. S. was passed to give effect to the Treaty and its pertinent portions read as follows:

“An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application

in this country is filed within twelve months in cases within the provision of section forty-eight hundred and eighty-six of the Revised Statutes.”

The wording of the Statute and its predecessors is perfectly plain, and it has been so recognized in the following cases:

Tilghman v. Proctor, 102 U. S. 707, p. 709;

Johnson Bros. Eng. Corp. v. Masters, 49 F. (2d) 187, p. 191 (C. C. A. 7th).

**CONTROLLING AUTHORITY AS TO PRIORITY OF
STORCH PATENT.**

The subject matter disclosed,—not the subject matter claimed,—determines the question of identity as well as priority.

Milburn Co. v. Davis-Bournonville Co., 270 U. S. 390, pp. 399-402.

In this case the Supreme Court reversed the decision of the Circuit Court of Appeals for the Second Circuit, which in this and several earlier decisions had announced a contrary rule. The lower Court had held that a patent which disclosed, without claiming, a given invention, did not anticipate a patent to a later inventor who did in fact claim the invention. The Supreme Court held that what was not *claimed* by the *first* applicant became abandoned to the public. A later inventor cannot recapture it.

In the *Milburn* case, the facts were as follows:—
One Clifford applied January 31, 1911 and his patent issued February 6, 1912.

One Whitford applied March 4, 1911 and his patent issued June 4, 1912.

Clifford *disclosed* but did not *claim* what Milburn's patent covered.

Whitford, the later applicant, proved no date of invention prior to Clifford's application.

From the decision we quote the following:

“The question is not whether Clifford showed himself by the description to be the first inventor. By putting it in that form it is comparatively easy to take the next step and say that he is not an inventor in the sense of the statute unless he makes a claim. The question is whether Clifford's disclosure made it impossible for Whitford to claim the invention at a later date. The disclosure would have had the same effect as at present if Clifford had added to his description a statement that he did not claim the thing described because he abandoned it or because he believed it to be old. It is not necessary to show who did invent the thing in order to show that Whitford did not.”

The Court also held it immaterial whether Clifford's patent had,—or had not,—actually issued before the date of Whitford's application.

In the case at bar the Treaty and Section 4887 put Storch in exactly the same position that Clifford occupied in the case before Supreme Court. Both Storch and Shoemaker were foreigners, but under the Treaty and the Statute Storch was on an identical footing with any United States citizen.

If he had not applied for a patent in the United States within twelve months from the date of his Austrian application, on September 1, 1928, the fact that he was a first inventor would have been of no avail, for Section 4923 would then have applied. Foreigners who do not apply for patents in this country do not acquire any rights or any *status as inventors*, either under the Treaty or under our laws. But those who conform to the Treaty and Section 4887 do acquire such rights, and the public acquire, through them, the benefit of their disclosure.

Whatever the inventor does not claim, is acquired immediately. What he does claim becomes public property upon expiration of the patent. The theory of Counsel that a later inventor can include within the scope of his monopoly whatever the earlier inventor failed to claim, was exploded by the Supreme Court in the *Milburn* case.

SECTIONS 4886 AND 4923, R. S. U. S.

Counsel for Plaintiffs lays great stress on his argument that the Shoemaker application, filed December 24, 1928, was accompanied by the "usual oath", and that he does not know and does not believe that his invention was ever before known or used.

But Storch made the same oath to his U. S. application, and that application has an *effective* filing date of September 1, 1928, which is earlier than Shoemaker's date of conception. Both Storch and Shoe-

maker are foreigners. Therefore, if Section 4923 could be applied to such a situation, it establishes the priority of the Storch patent as against anything that Shoemaker did at any time.

However, Section 4923, *on its face*, applies only to prior knowledge and use in a foreign country. It does not purport to deal with patent rights established under the Treaty, and which, under the decision in the *Milburn* case, carry through to the issuance of a patent regardless of the date of issuance.

Inventions are the work of inventors. Elaborate drawings, specifications and claims are the work of patent solicitors. In the *Milburn* case, if the attorneys for Whitford and Clifford had been reversed, the apparent scope of the respective patents would have been reversed. Similarly, if the attorneys for Shoemaker and Storch had been reversed, the apparent scope of their respective patents would have been reversed, and Storch might have obtained 28 claims, each containing expressions shrewdly phrased to appear to the Official Examiner as words of limitation, but open to interpretation by a professional expert to mean exactly what the Official Examiner refused to allow. Such practices tend to bring all patents into disrepute.

**DECISIONS FOLLOWING MILBURN CO. v. DAVIS-
BOURNONVILLE CO., SUPRA.**

- Mershon v. Sprague Specialties Co.*, 95 F. (2d) 313, p. 319 (C. C. A. 1st);
Craftint Mfg. Co. v. Baker, 94 F. (2d) 369, p. 371 (C. C. A. 9th);
Nelson v. Wolf, 97 F. (2d) 632 (C. C. A. 2, 1938).
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TEACHING OF STORCH SPECIFICATION.

At the trial, Plaintiff's expert said he could find no justification for Defendants' Ex. U, having omitted the Storch lazy tongs, and no justification of the fact that in Defendants' Ex. U the draping frame unfolds in a clockwise direction and folds for secondary draping purposes in a counter-clockwise direction.

The witness certainly went far afield in this effort to minimize the disclosures in the Storch patents and the force of Ex. U, for it is elementary that to omit a part together with its function does not create a new invention, and that to reverse a movement without changing the principle of operation, does not change the character of the invention. But if the expert had made a real effort to find justification for Ex. U in the Storch specification, he would most certainly have found it in both of the Storch patents. The lazy tongs are described as a feature to be either used or omitted from the basic combination of the link bars with the central clothes support or draping frame which the link bars connect with the suitcase cover.

From page 2 of the Storch U. S. patent we quote the following, commencing with line 70:

“Obviously instead of the garment supporting unit B being in the form of a releasable and extensible lazy tongs structure composed of a plurality of garment supporting frame elements pivotally connected with one another, said unit may be composed of only a single pair of end bars connected together by any desired number of rods on which garments may be hung.”

Also, from the Austrian patent translation, middle portion of R. 544, we quote:

“the insert can be so constructed that it consists of only two or more frames.”

The disclosure of the lazy tongs is merely a disclosure that they *may* be used if called for by the number of garments to be carried.

As to clockwise and counter-clockwise draping movements, it is clearly stated in both of the Storch patents that the clothes supporting unit B may be swung in *either direction* on its pivotal connection with the links to adjust the frame for draping, and that it will then be swung in a *reverse direction to complete* the draping or secondary folding of the garment if the garment has sufficient length for a four-ply fold. We quote the following, lines 14 to 16, page 2 of the U. S. patent:

“The unit B may be mounted on the frame A for swinging movement with respect thereto in any suitable manner.”

From the middle of the second paragraph, page 2 of the Austrian patent, we quote the following statement that the garment frames,—

“can be rotated in the stirrup in the direction of the arrow or also in the opposite direction.”

The exemplification of the Storch patents embodied in Defendants' Ex. W follows the above suggestions made in the Storch specifications and *is a substantial replica of Defendants' accused structure in all essential particulars.*

STORCH PATENT DISCLOSES THE ACCUSED STRUCTURE.

The features common to the Storch patent and Defendants' accused structure include the following:

(a) A clothes support connected by pivoted link bars to the lateral side walls of a suitcase cover near the hinged side of the cover, whereby the clothes support may be bodily projected out of the cover to a loading position, and into the cover to a packing position, by a swinging movement of the links.

(b) The clothes support is so pivoted to the swinging ends of the links that it can be rotated a one-half turn, when so projected, to present it in a loading position, and by a reverse movement to secondarily drape or wind the clothing on the frame, preparatory to swinging it on the links to a suspended position within the cover. The Storch specification says that this secondary drape can be accomplished by swinging the frame in *either*

direction from its loading position. When swung counter-clockwise its mode of secondary draping conforms *exactly* to that of the accused structures as is demonstrated by the cuts on pages 55, 58 of this brief. In these cuts only the essential part of the fixtures are illustrated. The Storch patent says that the lazy tongs may be omitted, if desired.

(c) The draping frame has a primary draping bar, normally in proximity to the hinged side of the cover and removable, with the frame, from that position to an elevated loading position above the suitcase body adjacent the side to which the handle is attached.

(d) The draping frame is so combined with the links as to allow the frame to be projected bodily out of the cover in the same manner as in the accused structure, instead of being merely tilted out, as disclosed in the patent in suit. After being projected by the links, the frame may be swung on its pivotal connection with the links to a convenient loading position.

(e) A stop 17 is used to support the links in the projected position, and another stop 20 is used to hold the draping frame in the loading position. In the accused structure, the links are supported in the projected position by a stop on the body of the case, and an ordinary stop of the one-way hinge type is used to hold the draping frame in loading position.

Therefore, the Storch patent discloses the Defendants' device.

A device which would infringe, if later, will anticipate, if earlier.

Killefer Mfg. Co. v. Dinuba Associates, 67 F. (2d) 362, p. 366.

REPLY TO APPELLANT'S BRIEF.

The major portions of Appellant's brief are answered in the foregoing pages of this brief, but it will be appropriate to reply to a few arguments which attempt to raise collateral issues. The first of these is the question of:

PLAINTIFF'S COMMERCIAL SUCCESS.

We have already quoted from the Record p. 143, a portion of the Shoemaker deposition, in which he testified to the importance of having his clothes support pivoted directly to the hinged wall of the cover as distinguished from a pivotal connection with the lateral side walls. He limited his claims to this feature,—when it became necessary to do so in view of the rejection of his broader claims.

Therefore the presumption is that if Plaintiff's sales of suitcases were increased by reason of this alleged invention, the increase was due to this feature,—the only feature which Shoemaker testified to be "more practical" than the draping frame connections of the prior art.

If there was public approval, it is to be inferred that it was due to this feature.

However, the testimony of Shoemaker and his Licensees as to the extent of sales wholly fails to show that their sales of suitcases were increased over the volume existing prior to Shoemaker's date of conception in 1928.

It is well settled that evidence of public demand and public approval requires much more adequate proof than has been furnished in this case.

Altoona Publix Theaters v. American Tri-Ergon Corp., 294 U. S. 477, p. 488.

EFFORTS TO DISCREDIT THE STORCH PATENT.

The extended effort to discredit the Storch patent plainly indicates that counsel fully realizes the pertinence of this patent. The various propositions upon which counsel attempts to rely will be taken up categorically, as follows:

(a)

It is urged that the Storch priority over Shoemaker is merely a personal right vested in Storch under Treaty Convention.

Of course, the right of Storch to establish himself as a first inventor within the meaning of our laws by applying for a United States patent within twelve months from the date of his Austrian application *was* a "personal right."

But when he *exercised* that right by applying for and procuring a United States patent *disclosing* the invention, he established himself as a first inventor

over anyone having a date of conception *later* than the date of his Austrian application. Thereupon he became a first inventor *with the same force and effect as if he had been a citizen of the United States and had applied for a United States Letters Patent on the 1st day of September, 1928.* All citizens of the United States became vested with the right to use that invention, subject only to the limited monopoly of the patent itself.

The Treaty and Section 4887 R. S. U. S. placed Storch in exactly the same position that Clifford occupied in *Milburn v. Davis-Bournonville, etc., supra,* and Appellees have the same rights under Storch that were accorded to the Defendants in the *Milburn* case as against the Whitford patent. The Supreme Court held that Whitford was not a first inventor and could not claim anything that Clifford disclosed. It necessarily follows that Shoemaker cannot claim anything that Storch disclosed.

Therefore, Counsel's attempt to overrule the Supreme Court must fail.

(b)

It is contended in Appellant's brief that Section 4923 sets aside the Treaty and the provisions of Section 4887 even though Section 4923 deals with a wholly different set of facts, viz., a set of facts which would have existed if Storch had *not* availed himself of the Treaty rights and of the provisions of Section 4888.

If Storch had not applied for a United States patent, it would have been of no avail for him to prove, or

for Appellees to prove, that Storch made and sold his suitcases in Austria. Under the decision of *Westinghouse v. General Electric*, referred to in the Plaintiff's brief, it would have been of no avail to the Appellees to prove that Storch sent blue prints of his suitcase into the United States on September 1, 1928. Section 4923 deals with such situations, *but, on its face, it does not purport to deal with situations which come within the Treaty Convention.*

These three sections of the Statute 4887, 4888, and 4923, must be construed together, and when so construed it is perfectly clear that to obtain a valid patent the applicant must be the first inventor; that he is the first inventor even if he is a foreigner and applies for a patent first in a foreign country and then in the United States within the statutory twelve month period unless some one else could show an earlier date of invention within the meaning of United States laws.

Counsel quotes the following from *Westinghouse v. General Electric*, 207 F. 75:

“The patent granted to a person here is not void, and is not to be denied to an original inventor here, for the reason *merely* the invention had been known or used in a foreign country before his invention or discovery thereon.”
(Italics ours.)

If counsel had noted the word “*merely*” in the above quotation it would have been clear even to him that the basis for the decision in the *Westinghouse* case recognizes that if the user in the foreign country had applied for a patent there and followed it with an

application in the United States within twelve months thereafter, his prior inventorship would not be based *merely* on the foreign use nor upon his blue prints.

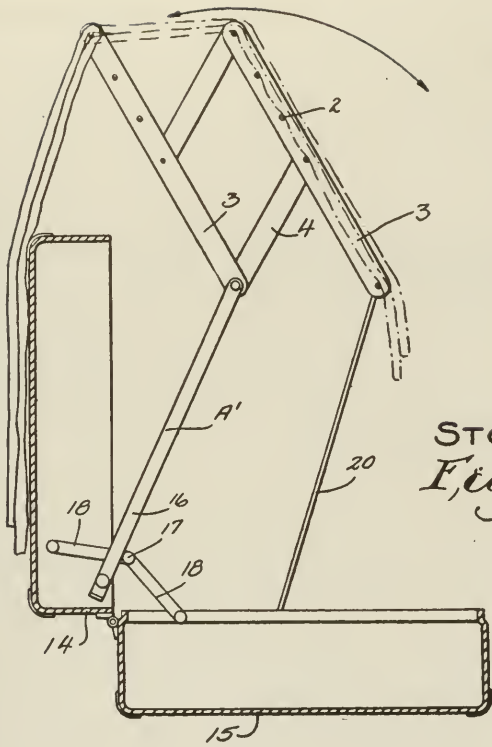
In the case of *Electric Storage Battery Co. v. Shimadzu*, 307 U. S. 5, referred to in Counsel's brief, the essence of the decision was that *because* Shimadzu *had* availed himself of his Treaty rights and his rights under Section 4887, he could carry his date of invention back of even his foreign filing date. Having established himself as a *prima facie* first inventor under the Treaty, he could go back to his date of conception and first reduction to practice, whereas, but for the Treaty and Section 4887, he would have been barred and the public would have been barred under Section 4923 from showing what Shimadzu did in Japan.

(c)

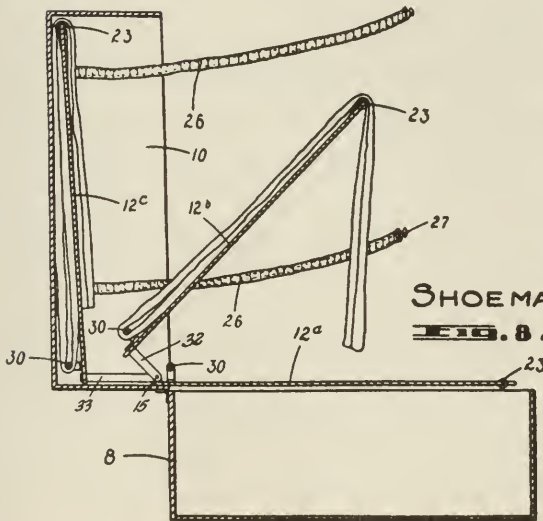
Plaintiff's Objection to the Storch Structure as Clumsy.

It is probably a sufficient answer to this objection to reproduce on the opposite page, for the purpose of comparison, Figure 4 of the Storch patent (with broken parts replaced), and Figure 8 of the patent in suit.

These views illustrate the respective patentee's ideas of means for providing a suitcase cover with a plurality of draping frames. The Storch Figure 1 illustrates three draping frames, whereas Figure 8 of the patent in suit illustrates only two. Even at that, there is little difference in clumsiness, and the followers of the Plaintiff, as well as the followers of Storch, have abandoned the teachings of the respective patents in



STORCH
Fig. 4.



SHOEMAKER
FIG. 8.

this regard and adopted the Pownall battery of draping bars.

This is a sufficient answer to the charge of clumsiness.

(d)

Plaintiff's Objections to Defendants' Exhibit U (R. 690), and Physical Exhibits V and W.

Exhibits U, V and W do not pretend to represent the drawings of the Storch patent. Neither were they offered as proof that Storch anticipated the claims in issue if properly interpreted.

On the contrary, these exhibits were offered to show that Defendants' suitcases have followed the teaching of the Storch specification and not that of the Shoemaker specification. The Storch specification says that the extra clothes support and lazy tongs may be omitted. He shows in Figure 4 that stop 17 may be substituted for the stays 5a shown in Figures 1 and 3, and a stop at the upper end of the link bar A' is plainly implied.

His specification also states that the clothes support may be swung in either direction to wind the clothes thereon for secondary draping, and this plainly implies that the angle of the link bars A' would be changed to provide clearance if the swinging movement is to be reversed.

This is all that Defendants have done. Defendants' suitcases have simply carried out these suggestions, and Exhibits U, V and W demonstrate that fact. The situation is quite the reverse from the one which this

Court passed upon in *Bankers, etc. v. Pacific, etc.*, 18 F. (2d) 16. In that case the Defendant was attempting to jump the fence into the pasture provided by the patent in suit, whereas in the present case the Exhibits demonstrate that Plaintiff's expert testimony represents an attempt by the Plaintiff to jump the fence into the Storch pasture by urging an interpretation of the claims in suit to cover exactly what the Patent Office refused to allow.

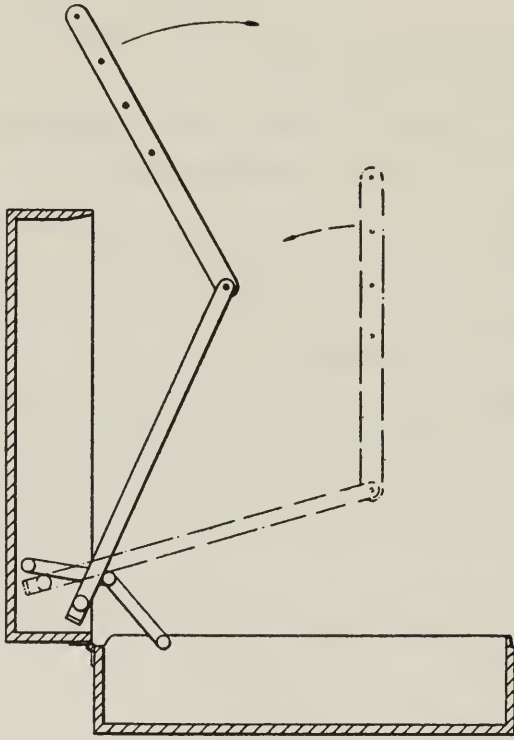
Exhibits U, V and W embody the identical *invention* disclosed by Storch, and nothing more.

That such variations as exist do not affect the question of identity, is fully established by the leading case of *Siemens v. Sellers*, 123 U. S. 276, where, on page 283, the Court says:

“They describe the same furnace in all essential particulars. The English specification is more detailed, and the drawings more minute and full; but the same thing is described in both.”

See also *United Peg-Wood Shank & Leather Board Co. v. B. F. Sturtevant Co.*, 125 F. 378, p. 381, (C. C. A. 1st).

The cut below is a replica of the Storch Figure 4, with broken parts restored. In dotted lines we illustrate what any mechanic would necessarily do to carry out the suggestion in the Storch specification, that the clothes support may be swung in the opposite direction.



STORCH FIG. 4 FIXTURE APPLIED TO
 DEFENDANT'S SUIT CASE FOR EITHER
 CLOCKWISE OR COUNTER-CLOCKWISE FOLDING

It is hypercritical to assume that ordinary mechanical knowledge and common sense will not be used in following the teachings of a patent, not only as to preferred forms, but as to suggested modifications.

Oliver-Sherwood Co. v. Patterson-Ballagh Corp.,
95 F. (2d) 70, p. 78 (C. C. A. 9).

If done for the purpose of carrying out the teaching of the Storch patent, it is not a departure to add, subtract or shift elements as any ordinary mechanic would be expected to do in order to embody the invention in commercial form.

Creed v. Potts, 37 Pat. Q. 512.

CONCLUSION.

The Decree of the Trial Court should be sustained upon the following grounds:

1. Upon the grounds of anticipation by Maurice Koch.
2. Upon the ground that Plaintiff's assignor, in procuring the patent in suit, defined the expression "hinged side of the cover" as meaning the base or wall of the cover to which the body hinges are attached, and did so to avoid a rejection of his claims upon prior art disclosing clothes supports pivoted to the respective side walls of a cover adjacent the hinged wall.
3. Upon the ground that Plaintiff is estopped to assert an interpretation of the claims in issue, which would give them sufficient scope to cover the accused suitcase, embody a bodily projectible clothes support

movable to an upright loading position, adjacent the handle side of the suitcase body.

4. Upon the ground that the accused suitcase is constructed in accordance with the teaching of the prior art, particularly that of the Storch patent, and that, if the accused suitcase infringes any of the claims, the Storch patent anticipates those claims.

Dated, San Francisco, California,
April 7, 1941.

Respectfully submitted,

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